the claimed invention *ipsis verbis* to comply with the written description requirement. *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978). Further, it is not necessary for a specification to describe that which is known in the art by one of ordinary skill in the art. *In re Myers*, 410 F.2d 420, 427 (C.C.P.A. 1969). Because one of ordinary skill in the art would understand the scope of the claims in light of the present specification, the present claims meet the requirements of §112, first paragraph and Applicants, therefore, respectfully request that this rejection be withdrawn.

The Examiner maintains that the term "long-wearing" is not clear and concise. In particular, the Examiner asserts that the term is not defined by a lower limit in the claims or the specification. In response to Applicants' previous arguments pertaining to this issue, the Examiner questions how one can determine if the composition is not long-wearing if they cannot determine the lower limit of long-wearing. Very simply, the composition is not long-wearing when it does not last on the skin for up to a full day. There is no requirement under section §112 that dictates that a range having a maximum and a minimum value must be present. A single comprehensive value can be sufficient. Whether it is considered the minimum or the maximum is irrelevant. What is reasonably known and understood by one of ordinary skill in the art upon reading the present specification is that the compositions of the present invention are "long-wearing" when the compositions are on the skin for up to a full day.

Another term found by the Examiner to be indefinite is the word "derived." The Examiner questions whether the claim refers to acrylic acid polymers or polymers derived from acrylic acid. It is not clear to Applicants how a polymer derived from acrylic acid is not an acrylic acid polymer. Therefore, the distinction apparently being made is not understood. As mentioned above, Applicants are not required to describe that which is known by one of ordinary skill in the art. Previously, Applicants demonstrated that one of ordinary skill in the art understands what the term derived means and in the context of the present claims it is understood that an acrylic acid polymer is synonymous with an acrylic acid derived polymer or a polymer derived from acrylic acid.

The Examiner maintains that the '072 reference and the '277 reference render Claims 1 to 21 obvious under 35 U.S.C. §103(a). Further, the Examiner notes that it appears that the two obviousness rejections have been coalesced. However, Applicants' statements jointly regarding these two rejections, does not mean, nor was it intended, that Applicants in any way coalesced these two arguments. It was previously asserted that each of the references, alone and in combination, at page 2 of Applicants Response of July 9, 2002, fails to render the present invention obvious. The compositions of the present invention utilize a simple acrylic or methacrylic acid polymeric system that permits the beneficial use of water

solubl pigments without the drawbacks of fading and running in an aqueous based system, as well as in the absence of the drawbacks associated with clogging.

The Examiner points out that the '072 reference teaches a water-soluble pigment because it discloses D&C Yellow No. 5 at column 6, lines 26 to 27. However, Applicants assert that this reference fails to teach or suggest a water-soluble pigment for two reasons. The '072 pigments are part of a solid portion in the oil phase of the '072 emulsion compositions, and are therefore, solids themselves which are inherently water insoluble. First, in two preceding paragraphs before the teaching of the '072 pigments, at column 6, lines 7 to 9, the pigments, present in the solid portion of the '072 compositions, are taught to include, *inter alia*, organic lake pigments, which are solids and are not water soluble. Second, the organic pigments are only disclosed as being present in the oil phase of the '072 emulsion compositions as indicated by the processing directions starting at column 7, line 5. Therefore, even if the organic pigments could somehow be considered to be water soluble, the '072 reference fails to teach or suggest placing the organic lake pigments in the water phase of the '072 emulsion compositions. There is no teaching or suggestion to arrange a specific combination of a water-soluble pigment with an acrylic or methacrylic acid polymer in an aqueous based system, such as those described in the present invention. Therefore, Applicants maintain that the '072 reference fails to teach or suggest the water soluble pigments of the present invention. The mere teaching of elements without connecting them to achieve the beneficial results of the present invention fails to place the present invention in the possession of one of ordinary skill in the art. The present invention, namely, a combination of a methacrylic or acrylic acid polymer and a water soluble pigment in an aqueous system is not taught or suggested by the '072 reference.

The Examiner also asserts that the motivation to combine the '072 reference with the '277 reference is to provide a colored composition that can be easily applied to the eye area. Applicants previously traversed this reasoning because the '277 reference teaches away from making the combination asserted by the Examiner. In response to this argument, the Examiner finds that the claims of the present invention are not commensurate in scope with a limitation directed to clogging or a wick-type nib. However, Applicants disagree with this finding because in Claims 15 to 18 and in Claim 22, specific reference is made to the flow-through applicator. Further, in the present specification at page 5, lines 13 to 15, the present invention is described as also including a flow-through nib-type pen and as having an added benefit of not clogging the wick of the pen. Therefore, Applicants assert that the claims are commensurate in scope of the argument regarding the teaching away by the '277 reference with respect to clogging when the claims are read in light of the specification.

The Examiner notes further that the '277 reference does not teach away from the combination because at column 1, lines 47 to 50 of the '277 reference it teaches that at a certain viscosity the '277 compositions will not cause clogging when used in a nib pen. However, Applicants point out that the '277 reference teaches water-soluble components in a water based system unlike that of the '072 reference. Thus, although the '277 compositions may not clog a pen at a certain viscosity, what is of primary importance is that the '277 reference teaches and/or suggests that clogging will occur if, as the Examiner suggests, the '277 pigments are present in the '072 compositions, specifically in the oil phase of the emulsion system. The pigments of the '072 reference are taught to be part of the solid portion present in the oil phase of the '072 compositions. Thus, the main point of Applicants argument has repeatedly been that the '277 reference teaches away from the combination of the cited references because the '277 reference, specifically at column 1, lines 22 to 31, teaches and clearly explains that oil causes clogging.

> [N]ib pens have not been employed as a delivery system for lipliner because conventional lipliner compositions employ wax or anhydrous (oil) base which are relatively viscous . . . and would therefore cause clogging of the wick.

One of ordinary skill in the art would not, therefore, combine the cited references because it would be expected that the oil present in the '072 compositions would cause clogging as taught by the '277 reference.

The benefit of the present invention, namely that with respect to not clogging, in addition to the benefits with respect to not running and not bleeding, is described in the present specification at page 3, lines 12 to 13, and page 5, lines 13 to 15 without the necessity of relying on the viscosity of the compositions. The ability to overcome both of these challenges is achieved with the compositions of the present invention, and is not taught or suggested by the cited references, alone or in combination. The '072 reference fails to teach or suggest water soluble pigments, and the '277 reference fails to teach or suggest the polymeric component of the present invention. The aqueous based system of the present invention containing the water soluble pigment and the acrylic acid polymer is not taught by the cited references. The fact that this combination, namely the water soluble pigment and the acrylic acid polymer, which is not taught or suggested by the cited references, achieves the benefits with respect to not clogging and not running are unexpected and surprising. Therefore, the method of combining these components is not obvious to one of ordinary skill in the art contrary to the assertion made by the Examiner based on the fact that mixing inherently is a known processing step. The criticality of the method is not related to the act of mixing, *per se*, but rather on the act of mixing the nonobvious combination of the acrylic or methacrylic acid polymer and the water soluble pigment in an aqueous base, which is not taught or suggested by the cited references.

Therefore, Applicants believe that the Examiner's statement that two old and well-known ingredients are obvious to combine sounds like an application of hindsight. Certainly, patentable inventions occur with combinations of old and well-known components. However, it is the specific combination that has not been recognized or placed in the possession of one of ordinary skill in the art that can be patentable, especially, where there are surprising or unexpected results. Applicants do not comment on the word "comprising" and the permission for additional steps. Rather, Applicants note that the steps of the invention are affirmatively claimed, and there is no need to include additional steps that anyone may add beyond the claimed invention. The claimed steps provided in the present invention, namely the combination of a methacrylic or acrylic acid polymer and a water soluble polymer in an aqueous based system, are not taught or suggested by the cited references. Thus, Applicants submit that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a), and Applicants request that the rejection under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

Accordingly, the claims are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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Dorene M. Price, Reg. No. 43,018
Estee Lauder Companies
125 Pinelawn Road
Melville, NY 11747
(631) 531-1194